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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,947	08/09/2000	Morten Nyborg	1359-00	3879

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EXAMINER	
NGUYEN, BINH AN DUC	
ART UNIT	**PAPER NUMBER**
3713	19

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/601,947	NYBORG, MORTEN	
	Examiner	Art Unit	
	Binh-An D. Nguyen	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2004* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

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6) ☐ Other:

DETAILED ACTION

1. The Amendment filed in Paper No. 18, September 19, 2003 has been received. According to the Amendment, claims 33 and 40-45 have been amended; and new claims 47 and 48 have been added. Currently, claims 33-48 are pending in the application. Acknowledgment has been made.

2. The amendment filed September 19, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In claim 42, the limitation of "wherein the key code transmitter comprises an automatically operating time slot selection component" has not been originally disclosed.

In claim 43, the limitation of "wherein the key code transmitter comprises a time selection component that randomly selects at least one of a duration of a time slot and a position of a time slot within a time unit" has not been originally disclosed.

In claim 44, the limitation of "wherein the key code transmitter comprises an automatically operating time slot selection component for randomly selecting at least one of a duration of a time slot and a position of a time slot within a time unit" has not been originally disclosed.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. Claim 40 is objected to because of the following informalities:

In claim 40, line 4, the recited phrase "the steps of" should be deleted since a system, not method, has been claimed. Appropriate correction is required.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 42-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations of "wherein the key code transmitter comprises an automatically operating time slot selection component" (claim 42); "wherein the key code transmitter comprises a time selection component that randomly selects at least one of a duration of a time slot and a position of a time slot within a time unit" (claim 43); and "wherein the key code transmitter comprises an automatically operating time slot selection component for randomly selecting at least one of a duration of a time slot and a position of a time slot within a time unit" have not been originally disclosed. Note that, in the specification (page 4, lines 28-32, and Figure 2) the transmitter 13 is and independent unit; and other data, including data from time slot generator 11 or data from time unit generator 10, are transmitted to the television

via the transmitter. Thus, the transmitter as disclosed, does not comprise an automatically operating time slot selection component or time selection component as claimed.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 33-48, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Llenas et al. (5,271,626) in view of Katz et al. (5,109,404).

Llenas et al. teaches a system and method for announcing key codes (game clues) to TV viewers via the screen of their TV set in establishing contact between selected viewers and an established game program over a telecommunications network (Figs. 5a-7) comprising: a key code generator (40, 74, 100) for generating key code (game clues) to include a plurality of descriptive elements (5:13-27; 7:42-45), the key code being selected randomly among a predetermined number of different key codes (4:34-54); a key code transmitter for transmitting the key code in succession to the TV screens within a plurality of selected time slots located within a plurality of selected time units between a start and an end of a TV transmission which is at least one of a TV program and a TV commercial spot (4:26-66 and 8:24-41); a line connector for connection of viewers to the game program who by using the key code manage to establish the contact (3:47-59); the selection of the key code is accomplished

automatically (3:1-59); the selection of the time slots is accomplished automatically; duration and position of the time slot within the time unit is selected at random (6:55-68); at least one of duration of descriptive elements of the key code on TV screen and position of descriptive elements within the time slot is selected at random; random selection is made automatically; viewer connection is made via one or more selected from the group consisting of a telephone network; and the descriptive elements each comprises one or more selected from the group consisting of symbols, numbers, and letters (Fig. 4a). Note that, the applicant's disclosed key codes which "can be made up completely or partially of, e.g., digits in a telephone number, symbols, letters or combination thereof" (applicant's disclosure, page 3, lines 16-17) are equivalent to Llenas et al.'s clues which comprise letters and digits (3:47-59 and Figures 4a).

Llenas et al. does not explicitly teach the limitation of providing access (or means thereto) to the game program by a predetermined number of viewers who use the key code to establish said contact with the game program (claims 33 and 40). Katz et al., however, teaches a telecommunication network for playing game which controls the number of calls made to the central net work to prevent call over load (2:51-68; 3:57-4:32; 5:62-6:7; 8:12-20 and Figures 1-2).

Since a telephone network can handle so much incoming calls, would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the television game of Llenas with the method of controlling call routing, as taught by Katz et al., to come up with a telecommunication game network that provides a more reliable

access to the network game thus attract both television viewers and game players and increase advertising profit.

8. Applicant's arguments filed in Paper No. 18 have been fully considered but they are not persuasive.

Applicant's remarks regarding "The Examiner considers 'game clues' analogous to a 'key code generator'... " (Applicant's remarks page 6, line 18 to page 7 line 16) is not well taken. It has been considered that the claimed "key code," not "key code generator," is equivalent to Llenas et al.'s "game clues." Since the claimed key codes are used to access a game, and further, the key codes can be a telephone number or letters, they are considered equivalent to the game clues of Llenas et al. which comprise letters and phone numbers (Figure 4a).

Applicant's arguments regarding applicant's claimed randomly generated key code not analogous to Llenas et al. (Applicant's remarks page 7, line 17 to page 8 line 2) is not persuasive. Llenas et al.'s random variable generator is randomly timing and inserting the game clues to the TV program (3:36-59; 4:34-54; 6:45-68; 7:38-45; 7:50-8:3; 8:35-41).

Applicant's arguments regarding the claimed game is contained in a game program on a computer to which a viewer must gain access by a computer or telephone (Applicant's remarks page 7, lines 1-9) are not persuasive since that limitation has not been claimed.

Further, applicant's argument that Llenas et al. does not teach transmitting key code elements in time units within TV programs or commercials (Applicant's remarks page 8, lines 10-25) is not persuasive. Llenas et al. teaches "Rather than detecting the ends of program 80 and commercials 82 in order to insert a clue into the black spaces therebetween, the clues are aired during regular programming time, albeit in significantly briefer segments" (7:51-55).

Furthermore, applicant's argument regarding providing access to only a predetermined number of viewers (Applicant's remarks page 8, lines 3-4) is moot in view of new ground of rejection.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Katz (6,016,344) teaches a telephonic-interface statistical analysis system.

Luxenberg et al. (5,013,038 or 5,120,076) teaches method of evaluation data relating to a common subject.

Junkin (6,193,610) teaches an interactive television system and methodology.

Von Kohorn (5,034,807) teaches system for evaluation and rewarding of responses and predictions.

Yoshinobu (5,684,256) teaches system and method for responding to two-way broadcasting programs.

Sherman (5,213,3370 teaches a system for communication using a broadcast audio sugnal.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on 703-308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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